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7590 03/01/2007  
Irma Blancas, Pathway Enterprises, Inc  
936 Brady  
San Antonio, TX 78207

EXAMINER
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RAHMJOO, MANUCHER

ART UNIT	PAPER NUMBER
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2624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/01/2007	PAPER

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If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.



## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1- 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 1 and 6 applicant claims providing an agent to inspect said individual prior to a fingerprint scan comprising of:

1. inspecting said individual's fingertips
2. rejecting said individual for a fingerprint scan if said agent determines fingerprint scan will be invalid.

The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d

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1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). As such examine fails to see any "useful, concrete and tangible results" as claimed by applicant.

Examiner reviewed the application to identify any asserted use. The applicant is in the best position to explain why an invention is believed useful. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful. Such a statement will usually explain the purpose of the invention or how the invention may be used. Regardless of the form of statement of utility, it must enable one ordinarily skilled in the art to understand why the applicant believes the claimed invention is useful. See MPEP § 2107 for utility examination guidelines.

As per claim 11 applicant also claims said steps as discussed above along with a software application with means of indicating whether said individual's fingerprint scan matches an existing fingerprint template whereby said method increases the trustworthiness of a fingerprint or fingertip scan to identify an individual for authorization of an action. As evident by the claim language, a "software application" is being utilized along with other steps which were rejected earlier under 35 U.S.C.101. said "software application " as claimed is used in a computerized process where the computer executes a set of instructions as set forth through the application and does not define any structural and functional relationship between the application and other claimed steps as claimed. Examiner fails to see any connectivity between user implemented steps rejected earlier as lacking practical application and the computer implemented code or software.

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Said step as described above do not produce a "useful, concrete and tangible results" as claimed by applicant and are therefore rejected under 35 U.S.C. 101.

Claims 1- 19 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1- 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claims 1- 19, applicant claims steps implemented by an agent along with a computer implemented step of "fingerprint scan matching". Examiner has reviewed the specification in its entirety and is unable to find any logical linkage of said non-practical, user implemented steps which include physical tasks along with said computer implemented step therefore resulting into subject matter which was not

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described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 13 line 2 applicant recites "..., wherever it resides,...". It is unclear what is residing or where it is residing.

As per claim 13 line 2 applicant recites "...if said individual's the fingerprint scan...". It is unclear what applicant is claiming.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kentucky State Police, Inked fingerprinting Techniques, presented by The FBI,  
P.1- 7

16 Fingerprint, Palmprint, and major case print recording, Division of Forensic  
Science, Latent Fingerprint Procedures Manual, P.1- 3

### **Inquiry**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Rahmjoo whose telephone number is 571-272-7789. The examiner can normally be reached on 8 AM- 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Bella can be reached on 571-272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mike Rahmjoo

February 20, 2007



**MATTHEW C. BELLA**  
**SUPERVISORY PATENT EXAMINER**  
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